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 Defendants AEROFLEX INCORPORATED,
 AEROFLEX COLORADO SPRINGS, INC.,
 AMI SEMICONDUCTOR, INC., MATROX
 ELECTRONIC SYSTEMS, LTD., MATROX
 GRAPHICS INC., MATROX
 INTERNATIONAL CORP., and MATROX
 TECH, INC.

UNITED STATES DISTRICT COURT
 NORTHERN DISTRICT OF CALIFORNIA
 SAN FRANCISCO DIVISION

RICOH COMPANY, LTD.,

Plaintiff,

vs.

AEROFLEX INCORPORATED, AMI
 SEMICONDUCTOR, INC., MATROX
 ELECTRONIC SYSTEMS LTD., MATROX
 GRAPHICS INC., MATROX
 INTERNATIONAL CORP., MATROX TECH,
 INC., AND AEROFLEX COLORADO
 SPRINGS, INC.,

Defendants.

SYNOPSISYS, INC.,

Plaintiff,

vs.

RICOH COMPANY, LTD.,

Defendant.

Case No. C03-4669 MJJ (EMC)

Case No. C03-2289 MJJ (EMC)

**EXPEDITED MOTION TO COMPEL
 ACCESS TO INFORMATION ALLEGEDLY
 COVERED BY THE PROTECTIVE
 ORDER, OR IN THE ALTERNATIVE, TO
 DE-DESIGNATE ALLEGEDLY
 CONFIDENTIAL INFORMATION AND
 ORDER THEREON**

I. INTRODUCTION

Synopsys and the Customer Defendants hereby move pursuant to Local Rule 7-10 for an order permitting their expert, Mr. Charles Van Horn, access to information that Ricoh has marked confidential, although as set forth below, Synopsys and Customer Defendants dispute that the information they want to show Mr. Van Horn is, in fact, confidential. Synopsys and the Customer Defendants seek expedited resolution of this matter because of the rapidly approaching June 19, 2006 deadline for opening expert reports.¹

II. FACTS

Synopsys and the Customer Defendants disclosed Mr. Van Horn pursuant to the terms of the Stipulated Protective Orders in place in this case on May 22, 2006, with the intention of using Mr. Van Horn, a partner at the law firm of Finnegan, Henderson, Farabow, Garrett & Dunner, LLP, as their inequitable conduct expert. Under the terms of the Stipulated Protective Orders, Ricoh was required to raise any objection to Mr. Van Horn's access to Ricoh confidential information in the case within ten days of the May 22 disclosure. Knowing that the date for submitting expert reports was fast approaching, Ricoh waited the full ten days to object to the designation of Mr. Van Horn, and then sent the following objection:

We recently received a notice from your firm that you had retained Charles Van Horn as a potential expert witness. Mr. Van Horn is a partner with the Finnegan Henderson law firm in Washington D.C. As you have long been aware, the Finnegan Henderson firm represents Elan Microelectronics Corp., which has received warning letters from Ricoh regarding the '432 patent. *See* SP68389 (enclosed). Under these circumstances, we object to your retention and designation of Mr. Van Horn

De Mory Decl., Exh. 1.

Although Synopsys and the Customer Defendants immediately disputed that this was a legitimate objection, they nonetheless contacted Mr. Van Horn and requested that the Finnegan law

¹ Because of Ricoh's litigation tactic of waiting 10 days to make its objection known and because, as explained below, Ricoh lacks any legitimate basis for its objection, Synopsys and the Customer Defendants request additional time (commensurate with the delay created by the objection) to complete their inequitable conduct report. Either Mr. Van Horn will need time to review the documents described herein, or Synopsys and the Customer Defendants will have to get a new expert up to speed. In addition, should the Court sustain Ricoh's objection, Synopsys and the Customer Defendants request that the Court modify the Protective Order to require that all future objections be made within three (3) business days.

1 firm put into place an ethical wall between Mr. Van Horn and any attorneys who work on the Elan
2 matter referenced in Ricoh's objection. Ricoh was immediately informed of the ethical wall, but Ricoh
3 still refused to lift its objection. De Mory Decl., Exh. 2. When it communicated its refusal to agree
4 that the ethical wall provided adequate protections, Ricoh stated:

5 We believe that Mr. Van Horn has a conflict of interest within his firm that should preclude
6 him from accepting the proposed engagement as an expert witness. In addition, Ricoh does not
7 want its confidential information to be disclosed to a law firm that is representing other parties
that Ricoh has contacted regarding licensing the same patent.

8 *Id.*

9 A further in-person meet and confer was conducted on this topic on Friday, June 3, 2006.
10 Ricoh reiterated its objection that it did not want a potentially adverse party to have access to its
11 confidential information. In addition, it also explained the alleged conflict. In particular, Ricoh's
12 counsel stated that there may be a conflict between Synopsys and the Customer Defendants on the one
13 hand, and Elan, on the other hand. During the meet and confer, Ricoh was informed that it lacked
14 standing to raise the conflict, and Ricoh has failed to supply any authority to support its conflict theory.
15 Most notably, Ricoh has not adequately explained how there can be any conflict between Elan and
16 Synopsys and the Customer Defendants given that that Ricoh's claims against Elan appear to be the
17 same as against the other Customer Defendants – i.e., that Elan's use of the Synopsys tools infringes
18 the method of the '432 patent.

19 During the meet and confer, Synopsys and the Customer Defendants also informed Ricoh that
20 they would assert that the materials they desired to show Van Horn, which relate to inequitable
21 conduct, were not confidential in the first instance, and thus, the objection was not well-founded for
22 this reason as well. In particular, Synopsys and the Customer Defendants desire to show Van Horn
23 documents that are more than twenty years old relating to an on-sale bar, the alleged conception of the
24 invention (which has now long been made public by virtue of the filing of the application), the failure
25 to name known joint inventors, and related deposition testimony. Indeed, Ricoh has no basis to claim
26 as confidential even the source code for what it claims was the initial embodiment of the patent is
27 confidential given that this code is twenty years old and for a product Ricoh has not sold, used or
28 distributed for at least fifteen years. Simply put, there is no legitimate basis for claiming that this

1 information is confidential in the first instance. Synopsys and the Customer Defendants explained this
2 to Ricoh, and yet Ricoh declined to withdraw its objection.

3 Synopsys and the Customer Defendants submit, under seal, the documents it intends to provide
4 to Mr. Van Horn. De Mory Decl., Exhs. 3-6. Synopsys and the Customer Defendants would also
5 show Mr. Van Horn deposition testimony of Dr. Kobayashi, Mr. Oka, and Mr. Ishijima relating to
6 these documents and art known to Ricoh or ICC, which was not sent to the Patent Office. Given that
7 Mr. Van Horn will be testifying about inequitable conduct, given the duty of candor required in PTO
8 proceedings, it is hard to believe that Ricoh can legitimately claim anything relating to the Patent
9 Office proceedings confidential in any manner. Indeed, that Ricoh continues to claim confidentiality
10 only further reinforces the substantial evidence that demonstrates that inequitable conduct has, in fact,
11 been committed.

12 **III. ARGUMENT**

13 There is no basis for Ricoh's objection. Indeed, Ricoh has yet to come forward with any legal
14 support for its position notwithstanding the fact that it fully appreciates the urgency of the situation.
15 There is no legitimate basis on which to claim confidentiality as to the documents and testimony at
16 issue here, in the first instance. Moreover, although unnecessary under the circumstance, Mr. Van
17 Horn has already agreed to put in place an ethical wall that will prevent the attorneys who work
18 adverse to Ricoh on the Elan Microelectronics matter relating to the '432 patent from seeing the
19 alleged confidential information, or any information provided to Mr. Van Horn. In the face of these
20 facts, it appears as if Ricoh's entire objection – including waiting 10 days to make it – is nothing more
21 than an improper attempt to seek a litigation advantage with a frivolous objection.

22 With regard to the conflict claim, Ricoh has no standing to raise an alleged conflict between
23 Synopsys and the Customer Defendants, on the one hand, and Elan, on the other hand. Ninth Circuit
24 courts have followed the majority view that “only a current or former client of an attorney has standing
25 to complain of that attorney's representation of interests adverse to that current or former client.”
26 *Colyer v. Smith*, 50 F. Supp. 2d 966, 969 (C.D. Cal. 1999) (collecting and analyzing cases). *Colyer* did
27 leave open the possibility that, in egregious circumstances, a third party conflict can be raised;
28 however, to do so, the moving party must demonstrate an “invasion of a legally protected interest

1 which is (a) concrete and particularized, and (b) actual or imminent, not conjectural or hypothetical.”
2 *Colyer*, 50 F. Supp. 2d at 973, citing *Lujan v. Defenders of Wildlife*, 504 U.S. 555, 560 (1992); see also
3 *Canatella v. Stovitz*, 2004 U.S. Dist. LEXIS 24266, *10-*11 (N.D. Cal. Sept. 13, 2004) (following
4 *Colyer*). Ricoh has not done so – the conflict it complains about is in *Choate*, and is only hypothetical.
5 Moreover, Synopsys and the Customer Defendants have already agreed, in advance, to waive any
6 conflict should the Finnegan firm become adverse to Synopsys or the Customer Defendants provided
7 that an ethical wall is in place with regard to Mr. Van Horn. Indeed, Ricoh’s reliance on this alleged
8 possible conflict is truly ironic given that Elan’s alleged infringement apparently also stems from its
9 use of the Synopsys tools at issue in this litigation.

10 There is no legitimate basis for Ricoh’s objection to showing Mr. Van Horn confidential
11 information. Ricoh would have to show good cause for this Court to deny Mr. Van Horn access to the
12 information. See *Advanced Semiconductor Materials America, Inc. v. Applied Materials, Inc.*, 1996
13 U.S. Dist. LEXIS 21459 (N.D. Cal. Oct. 28, 1996) (granting Local Rule 7-10 request to permit expert
14 to access confidential information where opposing party could not articulate anything more than a fear
15 that a competitor would get confidential information). Ricoh has not and cannot come forward with
16 any good cause showing. Indeed, Mr. Van Horn is not a “competitive decisionmaker,” as defined by
17 case law. Neither Finnegan nor Elan is a Ricoh competitor. To the extent that Ricoh has any
18 legitimate concerns (which it does not), an ethical wall is already in place, which eliminates Ricoh’s
19 concerns regarding any potential transfer of the allegedly confidential information. Thus, even the
20 chance of disclosure to a potential adverse party or law firm has been eliminated. Moreover, the
21 Protective Order, to which Mr. Van Horn has already agreed to be bound, provides that information
22 will be used *for this litigation only*. 3/24/04 Stipulated Protective Order, ¶1. Ricoh has not even
23 articulated a legitimate fear of competitive or other harm. Even if it had, adequate precautions have
24 already been taken.

25 Moreover, it would be highly prejudicial at this point to require Synopsys and the Customer
26 Defendants to find an alternative expert. Ricoh’s objection is akin to a motion to disqualify Mr. Van
27 Horn so that Synopsys and the Customer Defendants will have to find another expert on Patent Office
28 practice and procedure, including the duties of disclosure and candor. “Policies militating against

1 disqualification include guaranteeing that parties have access to expert witnesses who possess
 2 specialized knowledge and allowing experts to pursue their professional callings.” *Space Sys./Loral v.*
 3 *Martin Marietta Corp.*, No. 95-20122-SW, 1995 U.S. Dist. LEXIS 22305, at *5-6 (N.D. Cal. filed
 4 Nov. 15, 1995) (citing *English Feedlot, Inc. v. Norden Labs., Inc.*, 833 F. Supp. 1498, 1504-05 (D.
 5 Colo. 1993)). Moreover, Mr. Van Horn has already done work analyzing all of the non-confidential
 6 information on which portions of his opinion will be based.

7 In addition, the time is very short. Even if Synopsys found and disclosed a substitute
 8 inequitable conduct expert today, that expert would not be able to begin viewing Ricoh confidential
 9 information until at least June 16, three days before the deadline for his or her expert report (assuming
 10 that Ricoh engaged in the same behavior as it did with Mr. Van Horn of waiting a full ten days before
 11 responding to Synopsys’ disclosure of that expert). And that, of course, assumes that Ricoh does not
 12 raise another frivolous objection to the subsequent expert. Thus, should the Court sustain Ricoh’s
 13 objection, Synopsys and the Customer Defendants respectfully request a modification of the Protective
 14 Order, and require Ricoh to object to any newly disclosed expert within three business days so Ricoh
 15 cannot use this litigation tactic in the future.²

16 Finally, with regard to Ricoh’s claim that the information is confidential, the Stipulated
 17 Protective Order in this case provides that:

18 “‘Confidential Information,’ includes but is not limited to, (i) proprietary technical information
 19 and specifications, (ii) trade secrets, (iii) confidential know-how, and (iv) proprietary business
 20 and financial information and any other non-public information, the disclosure of which is
 likely to have the effect of causing significant competitive harm to the disclosing party or party
 from which the information was obtained.

21 3/24/04 Stipulated Protective Order ¶ 3(a). Here, these 20 year old documents, and testimony about
 22 these documents and public prior art references that were not submitted to the patent office, do not fall
 23 into any of the categories set forth above. Thus, in the alternative and pursuant to Paragraph 12 of the
 24
 25

26
 27 ² Given the short time remaining, Synopsys and the Customer Defendants may disclose an additional expert in an
 28 abundance of caution. This, however, does not mean that Synopsys and the Customer Defendants will not be significantly
 prejudiced should they have to change experts.

1 Stipulated Protective Order, Synopsys and the Customer Defendants request that the Court de-
2 designate these documents.

3 **IV. CONCLUSION**

4 For the foregoing, Synopsys and the Customer Defendants respectfully request that either Mr.
5 Van Horn be permitted to view confidential information forthwith, or that the Court de-designate the
6 information. In addition, Synopsys and the Customer Defendants respectfully request additional time
7 to complete their inequitable conduct report commensurate with the time it has taken to resolve this
8 issue. Synopsys and the Customer Defendants further request that the Court modify the Protective
9 Order such that Ricoh must make all objections to future designated experts within three (3) business
10 days.

11 Dated: June 5, 2006

Respectfully submitted,

12 HOWREY LLP

13
14 By: /s/Denise M. De Mory

15 Denise M. De Mory

16 Attorneys for Plaintiff

17 SYNOPSIS, INC. and for Defendants
18 AEROFLEX INCORPORATED,
19 AEROFLEX COLORADO SPRINGS,
20 INC., AMI SEMICONDUCTOR, INC.,
MATROX ELECTRONIC SYSTEMS,
LTD., MATROX GRAPHICS, INC.,
MATROX INTERNATIONAL CORP.,
and MATROX TECH, INC.

21 **ORDER**

22 Ricoh's objection to Charles Van Horn is overruled. In addition, Synopsys and the Customer
23 Defendants' deadline to serve an inequitable conduct is extended by _____ days. In addition, the
24 Stipulated Protective Order is modified such that any objection to a designated expert shall be made
25 within three (3) business days.

26 DATED: _____

27
28 _____
EDWARD M. CHEN

United States Magistrate Judge